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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,473	02/21/2001	Mikio Kawamoto	1095.1161/JDH	6202

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EXAMINER

HOSSAIN, TANIM M

ART UNIT	PAPER NUMBER
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2145

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/788,473

Applicant(s)

KAWAMOTO, MIKIO

Examiner

Tanim Hossain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer-readable storage medium includes the use of transmission media, as discussed on page 37 of the specification, which is not statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiman (U.S. 2002/019827) in view of Prompt (U.S. 6,985,905), in further view of Voticky (U.S. 6,351,764).

As per claim 13, Shiman teaches an email client apparatus for transmitting and receiving email messages comprising: a sorting unit which sorts email messages into a hierarchical

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structure according to sender addresses (paragraphs 0156-0158); and a list displaying unit which displays a list comprising the sender addresses arranged in tree form, together with titles of the email messages corresponding to the sender addresses (0156-0158). Shiman does not specifically teach that the sender addresses comprise a plurality of labels. Prompt teaches an email sorting system, in which the emails are sorted by sender, and labels are assigned to them, according to their level in the hierarchy (abstract, figure 23B). It would have been obvious to one of ordinary skill in the art at the time of the invention to include labels on the sorted emails. The motivation for doing so lies in the fact that assigning labels would allow for easier visual discrimination of different messages. Both inventions lie in the same field of endeavor, namely the sorting of electronic messages. Shiman-Prompt does not specifically teach that the labels represent domain names. Voticky teaches the arrangement of email messages by domain name (paragraph 0027). It would have been obvious to combine Voticky's arrangement by domain name, into Shiman-Prompt's system of placing emails into a hierarchy, in which different hierarchical levels correspond to different labels, to arrive at the claimed system of arranging emails by domain name, and having labels correspond to them. The motivation for doing so lies in the fact that adding the concept of sorting by domain name enables further functionality of an email system in which sorting by sender takes place, so that searching and viewing is further facilitated. All inventions are from the same field of endeavor, namely the sorting of electronic mail.

As per claim 14, Shiman-Prompt-Voticky further teaches that said list displaying unit places the label representing the top-level domain as a root node of the tree form and then

attaches thereto the other labels representing successively lower levels as branch nodes (Prompt: figure 23B).

Claims 15 and 16 are rejected under Shiman-Prompt-Voticky on the same bases as claims 13 and 14, as the instant claims recite limitations similar to those of the earlier claims.

As per claim 17, Shiman-Prompt-Voticky teaches a computer-readable storage medium storing an e-mail client program for displaying e-mail messages, the e-mail client program causing a computer to function as: a sorting unit which sorts e-mail messages into a hierarchical structure according to a user selectable parent-child attribute and the sender address, each comprising a plurality of labels representing different levels of domain names, referring first to the label representing a top level domain (Shiman: 0156-0158; where the messages are sorted in a hierarchical structure according to a sender address; Prompt: abstract, figure 23B; where the sorting of items are done according to a user selectable parent-child attribute; Voticky: abstract, 0027, figure 3; where the addresses are sorted by domain name and are indicated as such, where a top level domain is listed first); and a list displaying unit which displays a list comprising indicia of the labels of the sender addresses arranged in tree form, together with titles of the e-mail messages corresponding to the sender addresses (Shiman: 0156-0158; Prompt: abstract, figure 23B; Voticky: 0027, figure 3).

Response to Arguments

Applicant's arguments filed on October 30, 2006 have fully been considered, but are not persuasive.

a. Applicant asserts that Shiman-Prompt-Voticky does not teach “sorting e-mail messages into a hierarchical structure according to sender addresses each comprising a plurality of labels representing different levels of domain names, referring first to the label representing a top-level domain.” Examiner respectfully disagrees. Shiman teaches the staggered presentation of e-mail addresses according to sender addresses, and refers first to the top-level (0156-158). This constitutes sorting into a hierarchical structure according to sender addresses. Prompt teaches sorting e-mails comprising a plurality of labels, which represent different levels (figure 23B). Voticky teaches the sorting of e-mail addresses by different domain names (0027). Together, these teachings arrive at the claimed “sorting e-mail messages into a hierarchical structure according to sender addresses each comprising a plurality of labels representing different levels of domain names, referring first to the label representing a top-level domain.” Therefore, combining the teachings of Shiman-Prompt-Voticky arrives at the claimed limitation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanim Hossain whose telephone number is 571/272-3881. The examiner can normally be reached on 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Jason Cardone can be reached on 571/272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tanim Hossain
Patent Examiner
Art Unit 2145



JASON CARDONE
SUPERVISORY PATENT EXAMINER